

RESTRICTION REQUIREMENT

The Examiner has required restriction of the claims of this application under 35 U.S.C. § 121 into one of the following four Groups:

- Group I: Claims 1-34 drawn to a method for repairing a defect locus in a nonarticular cartilage tissue of a mammal comprising differing osteogenic proteins such as OP-1, OP-2, OP-3, etc. and drawn to the sequences set forth in SEQ ID NOS: 3-7, from which an election of one sequence is required, classified in class 514, subclass 2;
- Group II: Claims 35-46 drawn to an implantable device comprising differing osteogenic proteins set forth in SEQ ID NO NOS: 3-7, from which an election of one sequence is required, classified in class 435, subclass 283.1;
- Group III: Claims 47-50 drawn to a method for promoting chondrogenesis, classified in class 514, subclass 21; and
- Group IV: Claims 51-56 are drawn to a method of repairing a defect locus in a ligament in a mammal, classified in class 514, subclass 2.

The Examiner asserts that the inventions encompassed by Groups I-IV are patentably distinct from one another and have acquired a separate status in the art. Specifically, the Examiner contends that inventions I and II are patentably distinct because the claims consists of

different osteogenic proteins, having different structure, and thus, different properties and function. The Examiner further contends that inventions I-IV are patentably distinct because the methods of Groups I, III and IV do not mention the use of the device of Group II, and thus, can be used separately. Moreover, the Examiner asserts that the methods of Groups I, III and IV are patentably distinct because the methods have different method steps and end points. Accordingly, restriction to one of the four inventions is required. Applicants traverse.

Applicants request that the claims of Groups I and III be examined together. The Manual of Patent Examining Procedure (MPEP) states that there are two criteria for a proper requirement of restriction between patentably distinct inventions. The first is that the inventions must be independent or distinct as claimed. The second is that there must be a serious burden on the Examiner if restriction is not required. The MPEP further states that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions". MPEP § 803.

Whether the Examiner is correct in her "distinctness" contention is irrelevant. Here, there is no serious burden for the Examiner to search the claims of both Groups I and III because these searches overlap extensively, such that a search for the method of repairing a defect locus in a nonarticular cartilage tissue of Group I would reveal any art relating to a method for promoting chondrogenesis of Group III. Accordingly, applicants request that Groups I and III be rejoined.

Applicants request that the Examiner examine rejoined Groups I and III. If the Examiner does not agree

with applicants' proposal to rejoin Groups I and III, applicants provisionally elect with traverse the claims of Group I for initial substantive examination. 37 C.F.R. § 1.143.

Applicants further traverse the Examiner's restriction of SEQ ID NOs:3-7, and the requirement that applicants elect one Sequence ID NO. for further prosecution. Applicants note that claim 1 is a generic claim which links the species SEQ ID NOs:3-7. Upon allowance of generic linking claim 1, applicants shall request that any claims dependent therefrom or otherwise including the limitations of the allowable linking claim be entitled to examination in the instant application.

Notwithstanding, applicants elect Generic Sequence 9 (SEQ ID NO:6), with traverse, for further prosecution in this application. Applicants note that claims 1-34 read on elected SEQ ID NO:6.

This election is made expressly without waiver of applicants' rights to continue to prosecute and to obtain claims to the non-elected and/or canceled subject matter either in this application or in other applications claiming priority herefrom.

CONCLUSION

In view of the above, applicants request that the Examiner examine the pending claims in this application. Applicants request favorable consideration and early allowance of the pending claims.

Respectfully submitted,

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